

Amendments to the Drawings

The attached sheet of drawings includes changes to Figure 1. This sheet, which includes Figure 1, replaces the original sheet including Figure 1.

Attachment: Replacement Sheet

REMARKS

Summary of the Office Action

Claims 1-7, 9-15 and 17-21 were pending in the Office Action.

In the Office Action, the Examiner objected to the drawings as allegedly failing to show every feature of the invention specified in the claims. The Examiner rejected claims 1, 11-15 and 18 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,860,510 to Kotler ("Kotler"). The Examiner rejected claims 2-3 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Kotler in view of U.S. Patent Publication No. 2001/0034983 to Fanti ("Fanti"). The Examiner rejected claims 1-3, 5-7, 9, 11-15, and 17-18 under 35 U.S.C. § 103(a) as being unpatentable over International Publication WO 00/42274 to Shortland et al. ("Shortland") in view of British Patent No. 690,863 to Oakley ("Oakley"). The Examiner rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Shortland in view of Oakley and in further view of Fanti and U.S. Patent No. 5,597,194 to Daugherty et al. ("Daugherty"). The Examiner rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Shortland in view of Oakley and in further view of U.S. Patent No. 5,063,251 to Bergishagen ("Bergishagen"). The Examiner rejected claims 20-21 under 35 U.S.C. § 103(a) as being unpatentable over Shortland in view of Oakley and in further view of U.S. Patent No. 3,385,722 to Weaver et al. ("Weaver"). For the reasons detailed below, the rejections should be withdrawn, and the claims should be allowed to issue.

Applicant's Reply

In this Response, Applicant amends claims 1, 11, 15, 18 and 19 to more distinctly claim what Applicant regards as the present invention, adds new claims 22-26, amends the specification to fix a typographical error, submits a replacement sheet including a new Figure 1,

and addresses the Examiner's rejections. Support for the amendments to the claims and Figure 1 can be found throughout the application. For example, support for new claims 22 and 23 can be found at the description of Figure 2 at page 6 lines 4-14 and at page 7 lines 15-31 of the specification. Amendments to the claims are being made solely to expedite prosecution and do not constitute an acquiescence to any of the Examiner's rejections. Thus, no subject matter has been relinquished by such amendments. Applicant reserves the right to pursue these claims, prior versions of the claims, and/or the cancelled claims in another application. Applicant's silence with regard to the Examiner's rejections of the dependent claims constitutes a recognition by the Applicant that the rejections are moot based on Applicant's Amendment and Remarks relative to the independent claim from which the dependent claims depend.

Drawings

The Examiner objected to the drawings as allegedly failing to show every feature of the invention specified in the claims. Specifically, the Examiner indicated that the floor covering wound onto a core must be shown in the drawings. In order to expedite prosecution of this application, Applicants submit a replacement sheet herewith, including a new Figure 1, which shows the floor covering wound onto a core. Therefore, Applicants kindly request that the Examiner withdraw the objection to the Drawings.

Rejection under 35 U.S.C. §102(b)

The Examiner rejected claims 1, 11-15 and 18 under 35 U.S.C. § 102(b) as being anticipated by Kotler. Applicants respectfully submit that the cited art fails to anticipate claims 1, 11-15 and 18 and accordingly traverse the above rejections for the reasons set forth below.

Anticipation requires that each and every claimed feature be disclosed in a single prior art reference. Claim 1 has been amended to recite more clearly that the floor covering “has a decorative upper surface and a lower surface on which are embossed one or more studs” and “includes one or more particulate materials in the decorative upper surface of the floor covering to provide slip resistance.” Claim 18 has been amended to recite more clearly that the floor has “an upper surface and a slip resistant ventilating decorative floor covering” and “a lower surface on which are embossed one or more studs”

Kotler does not disclose or suggest a single sheet ventilating decorative floor covering having a lower surface on which one or more studs are embossed, as recited in independent claims 1 and 18. Instead, Kotler describes support legs which are formed by injection molding. (*See* Kotler, col. 4, line 65 to col. 5, line 2). Accordingly, claims 1 and 18 are patentable over Kotler for at least this reason.

Kotler also does not disclose or suggest a floor covering which includes one or more particulate materials in the decorative upper surface of the floor covering to provide slip resistance, as independent claims 1 and 18 recite. In fact, Kotler teaches away from including one or more particulate materials in the upper surface and there would be not motivation to modify Kotler to include a particulate material, as Kotler states that the “top surface is a flat finish.” (*See* Kotler col. 5, lines 17-18). Therefore, claims 1 and 18 are patentable over Kotler for at least this additional reason.

Additionally, Kotler does not disclose or suggest a single sheet plastics floor covering as recited in independent claims 1 and 18. In the Office Action, the Examiner notes that the claims do not recite the boundaries and/or dimensions of the flooring. Applicants respectfully submit that it is not necessary to do so. The claims explicitly define a covering for a floor that is “a single sheet.” Kotler, on the other hand, describes a floor covering that is formed

by interlocking modular tiles with other similar tiles to form a continuous flooring surface for use on playgrounds, gym floors and other rigid surfaces. (*See* Kotler, Abstract and col. 1, lines 6-10). Accordingly, Kotler does not disclose or suggest “a single sheet plastics floor covering” as recited in Claims 1 and 18. Therefore, claims 1 and 18 are patentable over Kotler for at least this additional reason.

Claims 11-15 depend, directly or indirectly, from claim 1. Therefore, claims 11-15 include all of the limitations of claim 1, in addition to the limitations recited in each individual dependent claim. Accordingly, because claim 1 is allowable over the cited art, claims 11-15 are also allowable for at least the same reasons applicable to claim 1. Furthermore, dependent claims 11-15 recite additional features not disclosed or suggested by the prior art of record.

For example, claim 11 further recites that “the floor covering is a heterogeneous floor covering made up from a plurality of layers.” Kotler does not disclose or suggest the use of a plurality of layers of plastic to form the described modular tile. Therefore, claim 11 is patentable over Kotler for at least this additional reason.

Claim 12 further recites a “floor covering . . . which includes a wear layer.” The Examiner states that the “flat finish on the top surface which is adapted for foot traffic is considered a wear layer.” (col. 5, lines 16-19). Applicant respectfully disagrees, as Kotler does not disclose or suggest a wear layer. Rather, the top surface 30 of Kotler is merely the upper surface of cushion plate 12 and not a further layer. (*See* Kotler, Column 5, lines 8-10). Additionally, Kotler does not disclose or suggest that the cushion plate is designed to withstand outside conditions. Therefore, claim 12 is patentable over Kotler for at least this additional reason.

Rejection under 35 U.S.C. §103(a)

Claims 2-3 and 19 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Kotler in view of Fanti.

To reject claims in an application under Section 103, an Examiner must establish a *prima facie* case of obviousness. Using the Supreme Court's guidelines enunciated in *Graham v. John Deere*, 383 U.S. 1, 17 (1966), one determines "obviousness" as follows:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

In *KSR Int'l Co. v. Teleflex Inc.*, the Supreme Court reaffirmed the *Graham* test, and indicated that although it should not be rigidly applied, a useful test for determining obviousness is to consider whether there is a teaching, suggestion or motivation in the prior art that would lead one of ordinary skill in the art to combine known elements of the prior art to arrive at the claimed invention. *KSR*, 550 U.S. ___, 82 USPQ2d 1385, 1396 (2007)). Importantly, the Court emphasized that a patent Examiner's analysis under Section 103 must be made explicit and there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

Applicant respectfully submits that Examiner's analysis under Section 103 is not explicit and that the Examiner has not provided articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

A person of ordinary skill in the art would not be motivated to combine Kotler and Fanti because the two floor coverings are constructed in a different and incompatible way. In Kotler, the lower surface of the disclosed modular flooring member is provided by flat, plastic support grid 11 which is formed by injection molding. (*See* Kotler, Column 4, line 65 - Column

5, line 2). In contrast, the plastics floor covering of Fanti is obtained by bonding several plastic film layers together. In Fanti, it is disclosed that during this bonding process, pressure can be applied by means of a rubber press to roughen the lower surface of the floor covering to enhance keying. (See Fanti, Paragraph 27). Therefore, the teaching of Fanti is not relevant to that of Kotler because the roughening of Fanti could not be applied to the modular tile of Kotler because it is constructed in a completely different way. For at least this reason, Applicant respectfully submits that Kotler and Fanti, either alone or in combination, do not render obvious the subject matter of claim 2-4 and 19.

Even assuming, *arguendo*, that a person of ordinary skill in the art were to combine the teachings of Kotler and Fanti, the combination would still not disclose or suggest all of the features of claims 2-3 and 19. Claims 2-3 depend from claim 1. Therefore, claims 2-3 include all of the limitations of claim 1, in addition to the limitations recited in the dependent claim. Fanti fails to cure the deficiency of Kotler, as described above with respect to claim 1, in failing to disclose or suggest a “a decorative upper surface and a lower surface on which are embossed one or more studs,” “one or more particulate materials in the decorative upper surface of the floor covering to provide slip resistance” and “a single sheet plastics floor covering” as recited in claims 1 and 19, because the covering of Fanti is “a plastics tile, which is made of a number of discrete predetermined shaped components which are joined together.” (See Fanti, Paragraph 6). Indeed, Fanti has only been cited by the Examiner as allegedly describing a roughened lower surface. Accordingly, because claim 1 is allowable over the cited art, claim 2-3 are also allowable for at least the same reasons applicable to claim 1. Therefore, claims 2-3 and 19 are patentable over Kotler and Fanti for at least these reasons. Furthermore, dependent claims 2-3 and claim 19 recite additional features not disclosed or suggested by the prior art of record.

For example, Claims 2 and 19 recite that the lower surface of the floor covering is chemically or mechanically modified to ensure that there is adequate grip between the lower surface of the floor covering and the floor to which it is applied. The Examiner relies on paragraph 15 of Fanti in arguing that Fanti includes a roughened lower surface. In Fanti, while paragraph 15 states that the lower surface of the discrete plastics components is roughened, there is no disclosure of how this is accomplished in Fanti. Thus Fanti does not disclose or suggest chemical or mechanical modification of the lower surface of the floor covering. For this additional reason, claims 2 and 19 are patentable over Kotler and Fanti, either alone or in combination.

Claims 1-3, 5-7, 9, 11-15, and 17-18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shortland in view of Oakley.

Applicant respectfully submits that Examiner's analysis under Section 103 is not explicit and that the Examiner has not provided articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

The Examiner has not stated what teaching, suggestion or motivation there is to combine Shortland and Oakley. In fact, Shortland and Oakley are unrelated and are directed to the solution of different problems. There is no teaching or suggestion in either document to combine the two. Shortland describes a stain resistant plastics floor covering. In contrast, Oakley describes a tile of India-rubber or rubber construction. Furthermore, a skilled person would not have been motivated to combine their teachings because they would not have expected that the ventilation provided by studs on the lower surface of a plastics floor covering would provide sufficient ventilation. Applicants note that a plastics floor covering is less resilient than the molded India-rubber or rubber tiles of Oakley. This flexibility of a plastics floor covering would have been expected to prevent the studs from ventilating the floor covering. For at least

this reason, Applicant respectfully submits that Shortland and Oakley, either alone or in combination, do not render obvious the subject matter of claims 1-3, 5-7, 9, 11-15, and 17-18.

Even assuming, *arguendo*, that a person of ordinary skill in the art were to combine the teachings of Oakley and Shortland, the combination would still not disclose or suggest all of the features of independent claims 1 and 18. In the office action, the Examiner admits that Shortland does not disclose or suggest a single sheet ventilating decorative floor covering having a lower surface on which one or more studs are embossed. Oakley also do not disclose or suggest a single sheet ventilating decorative floor covering having a lower surface on which one or more studs are embossed, as recited in independent claims 1 and 18. Instead, Oakley describes tiles of India-rubber or rubber composition which are molded. (*See* Oakley, page 1, line 61). Accordingly, claims 1 and 18 are patentable over Shortland and Oakley, either alone, or in combination, for at least this reason.

Since claim 1 is allowable, claims 2-3, 5-7, 9, 11-15 and 17 depending therefrom are also allowable.

Dependent claims 2, 3, and 5 recite additional features not disclosed or suggested by the prior art of record. For example, Shortland and Oakley do not disclose or suggest “a floor covering . . . wherein the lower surface of the floor covering is chemically or mechanically modified to ensure that there is adequate grip between the lower surface of the floor covering and the floor to which it is applied,” as recited in claim 2. The Examiner believes that the inclusion of plasticizer in the floor covering of Shortland would be sufficient for this purpose. However there is no disclosure in Shortland that the amount of plasticizer used would have this effect. Without such a disclosure, it would not have been obvious from Shortland to include sufficient plasticizer to ensure that there is adequate grip between the lower surface of the floor covering

and the floor to which it is applied. Therefore, claims 2, 3 and 5 are patentable over Shortland and Oakley, either alone or in combination, for at least this additional reason.

Claim 4 is rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shortland in view of Oakley and further in view of Fanti and Daugherty.

Claim 4 depends from claim 1. Therefore, claim 4 includes all of the limitations of claim 1, in addition to the limitations recited in the dependent claim. Fanti and Daugherty have only been cited as allegedly describing blowing agent that creates a roughened pattern and therefore fail to cure the deficiency of Shortland and Oakley as described above for claim 1. Accordingly, because claim 1 is allowable over the cited art, claim 4 is also allowable for at least the same reasons applicable to claim 1. Furthermore, Examiner has not stated what teaching, suggestion or motivation there is to combine the four cited prior art documents: Shortland, Oakley, Fanti and Daugherty. In fact, there is no teaching or suggestion in any of the documents to combine the four of them. A skilled person would not have been motivated to combine the teachings of Daugherty which relates to a plastic net with those of Shortland, Oakley and Fanti because the teachings of these four documents are unrelated and are directed to the solution of different problems. Applicants respectfully submit that only with the benefit of hindsight can it be said that it would have been obvious to make the combination. Therefore, claim 4 is patentable over Shortland, Oakley, Fanti and Daugherty, either alone or in combination, for at least this additional reason.

Claim 10 is rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shortland in view of Oakley and further in view of Bergishagen.

Claim 10 depends from claim 1. Therefore, claim 10 includes all of the limitations of claim 1, in addition to the limitations recited in the dependent claim. Bergishagen has only been cited as allegedly describing a blowing agent and therefore fails to cure the

deficiency of Shortland and Oakley as described above for claim 1. Accordingly, because claim 1 is allowable over the cited art, claim 10 is also allowable for at least the same reasons applicable to claim 1.

Additionally, a person of ordinary skill in the art would not be motivated to combine Shortland, Oakley and Bergishagen for at least the reasons stated above with respect to combining Shortland and Oakley. For at least this reason, Applicant respectfully submits that Shortland, Oakley, and Bergishagen, either alone or in combination, do not render obvious the subject matter of claim 10. Furthermore, there is no teaching or suggestion in any of the documents to combine the three of them, and there would be no such motivation because the teachings of these three documents are unrelated and are directed to the solution of different problems. Therefore, claim 10 is patentable over Shortland, Oakley, and Bergishagen, either alone or in combination, for at least this additional reason.

The Examiner rejected claims 20-21 under 35 U.S.C. § 103(a) as being unpatentable over Shortland in view of Oakley and in further view of Weaver.

The Examiner has not stated what teaching, suggestion or motivation there is to combine the three cited prior art documents: Shortland, Oakley, and Weaver. There is no teaching or suggestion in any of the documents to combine the three of them. Furthermore, a skilled person would not have been motivated to combine the teachings of Weaver with those of Shortland and Oakley because the teachings of these three documents are unrelated and are directed to the solution of different problems. It is submitted that only with the benefit of hindsight can it be said that it would have been obvious to make the combination. The floor covering of claims 20 and 21 has a lower surface on which are embossed one or more studs. Weaver teaches away from having a lower surface on which are embossed one or more studs because Weaver states that before the sheet (*i.e.* the floor covering) is wound on a collecting roll

23, pressure is exerted on the sheet sufficient to eliminate any surface irregularities which might be present in the sheet. (*See* Weaver, column 4, lines 72-74). Further Weaver describes using a pressure of about 200-800 pounds per linear inch. (*See* Weaver, column 4 lines 74-75). The one or more studs embossed on the floor covering of the present invention would be considered to the surface irregularities. Such studs would be eliminated by this application of pressure as described in Weaver. Thus a skilled person would not be motivated to combine the teaching of Weaver with that of Shortland and Oakley. And even if such a combination were made, it would not disclose or suggest a lower surface on which are embossed one or more studs and a floor covering which is wound onto a core, as claims 20 and 21 recite. For this reason, claims 20-21 are not obvious over Shortland, Oakley, and Weaver, either alone or in combination.

CONCLUSION

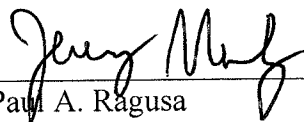
Entry of the foregoing amendments and remarks into the file of the above-identified application is respectfully requested. Applicant believes that pending claims 1-5, 7, 9-15 and 18-26 are in condition for allowance. Withdrawal of all rejections and reconsideration of the amended claims is requested. An early allowance is earnestly sought.

Should any additional fees be required, or if any overpayment has been made, the Commissioner is hereby authorized to charge any fees, or credit or any overpayments made, to Deposit Account 02-4377.

If there are any remaining issues to be resolved, Applicant respectfully requests that the Examiner kindly contact the undersigned attorney for early resolution.

Respectfully submitted,

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Paul A. Ragusa
Patent Office Reg. No. 38,587

Jeremy Merling
Patent Office Reg. No. 60,219

BAKER BOTTS L.L.P.
30 Rockefeller Plaza
New York, New York 10112-4498

Attorneys for Applicant
(212) 408-2500